

The opinion in support of the decision being entered today was **not** written  
for publication and is **not** binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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**Ex parte** Edward P. Daniels JR., Joseph D. Mallozzi,  
Robert K. Gottlieb, and James Giordano

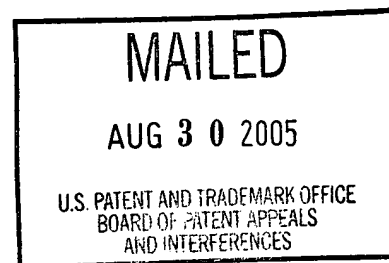
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Appeal No. 2005-1865  
Application No. 10/026,580

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**ON BRIEF**

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Before THOMAS, BARRETT, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-11,  
which are all of the claims pending in this application.

We REVERSE.

## **BACKGROUND**

Appellants' invention relates to a method of addressing and sorting an interoffice distribution using an incoming mail sorting apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of using an incoming mail sorting apparatus to sort employee mailings, method comprising the steps of:

a) printing employee address information on an unaddressed employee mailpiece using a printer situated along a feedpath of a mail sorting apparatus, the employee information obtained from at least one database of the mail sorting apparatus;

b) delivering the employee mailpiece to a destination bin designated by destination bin information stored in the at least one database of the mail sorting apparatus.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Axelrod et al. (Axelrod)	4,800,506	Jan 24, 1989
Allen et al. (Allen)	5,703,783	Dec. 30, 1997
Tripathi et al. (Tripathi)	5,832,504	Nov. 3, 1998
Petovsek	6,003,902	Dec. 21, 1999
Baker	6,156,988	Dec. 5, 2000

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Dec. 2, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Aug. 10, 2004) for appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

### 35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See *In re Rijckaert***, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See *In re Lintner***, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant

teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir.

1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations of independent claim 1. From our review of method independent claims 1, 2, and 8, we find that each independent claim sets forth the new use of an old (modified) machine, namely, the "incoming mail sorting apparatus" to address and sort newly formed/addressed mailpieces for in house distribution. Here, since the items were not in a stream a mail previously, they do not contain any printed address information and are hence "unaddressed."

Appellants argue that none of the teachings (Baker, Allen in view of Petkovsek, Axelrod and Tripathi) applied against the claims relate to the use of an incoming mail sorting apparatus to address, sort and deliver unaddressed mailpieces. (Brief at page 5.) Appellants address each of the applied references individually at pages 5-11 of the brief. We generally agree with appellants analysis of these teachings, and we do not find that the examiner has identified where in any of the applied references the references teach the use of an incoming mail sorting apparatus to address or print

employee address information on an unaddressed employee mailpiece, sort and deliver those mailpieces.

From our review of the examiner's statement of the rejection and the response to arguments section of the answer, we find no identification of incoming mail sorting apparatus beyond statements that one is present or discussion of claim interpretation or other basis for the examiner to not address or identify the use of an "unaddressed employee mailpiece." Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the invention as recited in the claims with respect to any of the prior art teachings.

Addressing the specifics of the individual prior art rejections, appellants argue that Baker teaches away from using a "sorting apparatus for 'printing the employee information on the unaddressed employee mailpiece' as it requires the employee addressing information must be printed on the mailpiece before being placed onto a sorter." (Brief at page 6.) We agree with appellants, and we cannot sustain the rejection of independent claims 1, 2, and 8 and their dependent claims.

With respect to the Allen patent, appellants argue "the Allen patent (and like the aforesaid Baker patent) explicitly teaches that in order for its mailpiece sorting apparatus to operate each mailpiece must contain a printed address before it is placed into the sorting apparatus (it is irrelevant if the printed address is a favored or disfavored one). Otherwise, 'placing unaddressed mailpieces on the incoming mail

sorting apparatus' as taught by the Allen patent would clearly produce an inoperative condition as the system taught by the Allen patent would have no way to determine a favored address for it." (Brief at page 7.) We agree with appellants. Furthermore, we do not find that Petkovsek remedies the deficiencies in Allen with respect to independent claim 8. Therefore, we cannot sustain the rejection of independent claim 8 and its dependent claims.

With respect to the Axelrod patent, appellants argue that

there simply is no incoming mailpiece sorting apparatus taught or suggested by the Axelrod patent. Applicants being a leader in the mailpiece industry respectfully disagree with the examiner's assertion that a mailbag is analogous to an incoming mailpiece sorting apparatus, which difference one skilled in the art would readily appreciate. Likewise, Applicants respectfully disagree with the examiner's assertion that any illustration in figs. 2a-2d and 3 depicting "sending printed letters to a letter stuffing module" is in any way analogous to an "incoming mailpiece sorting apparatus", which difference again one skilled in the art would readily appreciate. Simply put, a sorting apparatus has a plurality of destination bins, with each bin typically being designated to contain mailpieces addressed to a common location. Surely, a "mailbag" or a "letter stuffing module" cannot be said to teach or suggest a sorting apparatus. For instance, one skilled in the art would expect that a mailpiece generating apparatus as taught by the Axelrod patent would disclose addressing mailpieces since its function is to generate mailpieces. However, one skilled in the art would not expect to be able to "place unaddressed employee mailpieces on the incoming sorting apparatus" since such sorting apparatus are designed (with the exception of the present invention) only to be compliant with previously addressed mailpieces due to its inherent sorting processing. (Brief at page 9.)

We agree with appellants that Axelrod does not teach or suggest the use of an incoming mailpiece sorting apparatus to address and deliver unaddressed mail.

Additionally, we agree with appellants that there is simply no sorting performed in the

mailpiece generating apparatus taught by the Axelrod patent. (Brief at page 10.)

Therefore, the examiner has not established a ***prima facie*** case of obviousness, and we cannot sustain the rejection of independent claims 1, 2, and 8 and their dependent claims.

With respect to the teachings of Tripathi, appellants argue that Tripathi is concerned with a software product to generate reports and not to the use of an incoming mailpiece sorting apparatus or palcing unaddressed employee mailpieces on the incoming mail sorting apparatus. (Brief at pages 10-11.) We agree with appellants. Therefore, the examiner has not established a ***prima facie*** case of obviousness, and we cannot sustain the rejection of independent claims 1, 2, and 8 and their dependent claims.



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## CONCLUSION

To summarize, the decision of the examiner to reject claims 1-11 under 35 U.S.C. § 103 is reversed.

**REVERSED**

**JAMES D. THOMAS**  
Administrative Patent Judge

*Lee E. Barrett*  
LEE E. BARRETT  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

BOARD OF PATENT  
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JD/rwk

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